

**REMARKS**

The Office Action mailed October 17, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-11 and 14-22 were pending in the application. Claims 1, 3, and 14 have been amended, no claims have been canceled or newly added. Therefore, claims 1-11 and 14-22 are pending in the application and submitted for reconsideration.

This amendment changes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, are presented, with an appropriate defined status identifier.

Claims 1-11 and 14-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. patent 6,522,971 ('971 patent). Pending independent claims 1 and 14 recite, *inter alia*, that the server stores the destination data in correspondence with an user ID of a user operating the portable terminal and that map data to that destination is automatically generated based on the provided user ID. At least this recited feature is not recited, suggested or rendered obvious by any of the claims or disclosed by the specification of the '971 patent. Accordingly, the applied double patenting rejection is believed to be overcome and should be withdrawn.

In the Office Action, claims 1, 2, 14, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 5,197,009 to Hoffman, Jr., et al. (hereafter "Hoffman, Jr.") in view of U.S. patent 6,259,405 to Stewart et al. (hereafter "Stewart"). Claims 3-8 and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman, Jr. in view of Stewart and further in view of U.S. patent 6,324,467 to Machii et al. (hereafter "Machii"). Claims 9-11 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hoffman, Jr. in view of Stewart and further in view of U.S. patent application publication 2001/0056443 to Takayama et al. (hereafter "Takayama"). Applicants respectfully traverse these rejections for at least the following reasons.

The independent claims 1 and 14 recite, *inter alia*, storing the destination data in correspondence with an user ID of a user operating the portable terminal and that map data to that destination is automatically generated based on the provided user ID. This recited feature

is not disclosed or suggested by any of the applied references. Accordingly, the pending independent claims 1 and 14 are patentable over the applied prior art.

That is, as recited in amended Claim 1, an image forming system includes a portable terminal, a server and a printer, which are connected via a network. The server stores a desired destination data in a prescribed area in correspondence to a user ID set by the user who operates the portable terminal. The printer receives map data from the server via the network. The map data comprises a position data of the printer as a starting point and the destination data, which corresponds to the user ID set by the user and stored in the prescribed area of the server, as an ending point. The printer prints a map image on a recording medium based on the map data. Therefore, since the destination data has been specified beforehand to correspond to the user ID and stored in the server, when the printer prints a map image, only the ID input by the user is needed to specify the destination data. These claimed features are supported in the specification by, for example, figure 7 and its description in the text of the specification.

Such a system provides the benefit that the user does not have to separately specify the destination data at the printer (for example, at a convenience store) and simply providing the user ID results in a specific map from that printer to the destination (corresponding to the user ID) being printed on a recording medium. The above system and operation of the present invention is not disclosed by the cited references.

Neither the claimed features nor its advantages are disclosed or suggested by the applied prior art either singly or in reasonable combination. Accordingly, the pending independent claims are believed to be patentable over the applied prior art.

The dependent claims are also believed to be patentable for at least the same reasons as the respective independent claims on which they ultimately depend. In addition, they recite additional features which are also patentable when considered as a whole.

For example, claims 2 and 15 recite that the *printer* transmits the position data (set by GPS) to the server in order to receive map data from the printer to the destination corresponding to the user ID of the user of the portable terminal. The Office Action states on page 5 that “using GPS to determine position of a device would have been known.” However, Hoffman creates route maps from a known location to user specified destination(s)

and communication of the GPS position by the printer (whose address is known) to the server would be meaningless and would impermissibly alter the principle of its operation. The modem connection to a central database disclosed in Hoffman necessarily requires only a telecommunication addressing protocol (telephone number, for example) and transmitting GPS location of the printer would be meaningless in the context of the Hoffman system. Furthermore, in steps 62-65 in Fig. 5, Hoffman teaches loading a localized map based on a street address information for the printer and all route maps are generated from this known address. Therefore, the provision of GPS location from the printer of Hoffman is neither taught nor suggested by Hoffman and in fact would be meaningless in Hoffman's system. In this context, it should be noted that it is well established that hindsight reconstruction based on applicant's disclosure is impermissible. Accordingly, these recited features provide additional reasons for the patentability of these claims.

In view of the foregoing amendments and remarks, applicants respectfully request entry and reconsideration based on the instant amendment and reply because it is believed to place the application condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.

Respectfully submitted,

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